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APPLICATION NO. 08/963,332	FILING DATE 11/06/97	FIRST NAMED INVENTOR RONIN	ATTORNEY DOCKET NO. 55463-161-18
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EXAMINER LARKIN, B

ART UNIT 2856	PAPER NUMBER
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DATE MAILED: 01/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Supplemental
Office Action Summary

Application No.
08/965,332

Applicant(s)
BONIN

Examiner
Daniel Larkin

Group Art Unit
2856

☒ Responsive to communication(s) filed on 12 Dec 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 41-64 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 41-64 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claim 50 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which
 ✓ Re claim 50: The phrase "the means for measuring the output signal of the force sensor" lacks antecedent basis.

NOTE: The final rejection of 28 April 1998 is withdrawn in view of the new ground of rejection which follows.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the Assignee must fully comply with 37 CFR 3.73(b).

- 3. Claims 41-44 and 47-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 10-13, 18, 23, and 24 of U.S. Patent No. 5,553,486. Although the conflicting claims are not identical, they are not patentably distinct from each other because the term "high precision capacitance sensor" is defined by the claim structure of patent claims 1, 12, and 13. Moreover, the patent claims are narrower in scope than the application claims; and would therefore, encompass all of the limitations of the application claims.
4. Claims 45, 46, 53-55, and 57-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 10-13, 18, 23, and 24 of U.S. Patent No. 5,553,486 in view of Bonin (5,576,483). The patent to Bonin ('486) discloses a force sensor having a pair of capacitive transducers sharing a pick-up plate, means for mechanically transmitting a force between an object remote from the pick-up plate and the pick-up plate, and means responsive to the position of the pick-up plate relative to a drive plate for providing an output signal proportional to the relative position. The patent to Bonin ('486) fails

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to disclose the application of an AC signal to the drive plate, synchronously demodulating the output signal to produce a DC signal proportional to the displacement of the pick-up plate, controlling the movement of the scanning head in a two-dimensional horizontal direction, providing an image representative of the surface topography, or applying an alternating current carrier signal to the pair of drive plates, wherein the signal to one of the drive plates is 180 degrees out of phase with the signal to the other drive plate. The patent to Bonin ('483) discloses a high precision transducer comprising many of the same limitations disclosed by the other patent to Bonin ('486) in addition to applying an AC signal to the drive plate, synchronously demodulating the output signal to produce a DC signal proportional to the displacement of the pick-up plate, controlling the movement of the scanning head in a two-dimensional horizontal direction, providing an image representative of the surface topography, or applying an alternating current carrier signal to the pair of drive plates, wherein the signal to one of the drive plates is 180 degrees out of phase with the signal to the other drive plate.

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Daniel Larkin whose telephone number is (703) 308-6724. The Examiner can normally be reached on Monday-Friday from 7:00 AM - 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hezron E. Williams, can be reached on (703) 305-4705. The FAX telephone number for this Technology Center (Center 2800, unit 2856) is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.


Daniel Larkin

28 December 1998

DANIEL S. LARKIN
PATENT EXAMINER
GROUP 2800
Primary